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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER HYLINSKI, STEVEN J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,638

Applicant(s)

JOSHI ET AL.

Examiner

STEVEN J. HYLINKI

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-25 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-25, and 27-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 01/13/2009 have been fully considered but they are not persuasive.
2. To clarify any confusion over claim language interpretation, Examiner is interpreting the limitation of a "plurality of randomly selected outcomes" as including both base slot game symbol combinations as outcomes (Col. 3 Lines 3-4 and Col. 3 Lines 20-25 describe the structure for having pay tables, associated with the base slot game as shown in Fig. 1, pay table **132** and slot reels **114**) and also bonus game picks as outcomes (bonus game wins caused in blocks **244** and **246** of Fig. 2 are still randomly selected outcomes because the locations of selectable objects in a bonus game containing prizes is randomly selected in block **236** of Fig. 2). A bonus game pick resulting in a win can be interpreted as a "special-payout outcome". This winning bonus game pick "special payout outcome" meets the limitation of being provided by the basic game ("basic game having a plurality of randomly selected outcomes [...] including a special-payout outcome, as in Lines 3-5 of claim 1) because the bonus game picks would not exist if not for being triggered by the base game (Fig. 2 **216**).
3. Examiner respectfully disagrees with Applicants' interpretation that the prior art reference of Glavich as not changing the probability of a special-payout outcome occurring in the basic game. On the contrary, through a cause-and-effect relationship, the amount of a side-wager optionally placed (Fig. 2, the base wager is made, and Col. 3 Lines 65-67, Col. 4 Lines 1-2, in addition to this base wager a side wager may be

made), will affect the number of selectable items in a bonus game having a winning outcome, if the bonus game occurs (Columns 3-4, the number of "M" of selectable bonus game outcomes associated with a favorable result, can be based on the amount of the side wager made in addition to the base wager) the bonus game being triggered by a special outcome of the primary slot reel game (Fig. 2 blocks **214** and **216**), and therefore, changing the probability of the player winning a prize in the bonus game. As discussed above, winning bonus game picks can be considered "special-payout outcomes". In summary, by changing the number of selectable bonus objects, in accordance with the size of a side wager, associated with a winning outcome in a bonus game triggered from a special outcome of a base game, Glavich effectively provides more than one probability of winning a prize in a bonus game based on the side wager (special-payout outcome).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-2, 4-5, 7, 9, 29, 31-32, 34, and 36 are rejected under 35**

U.S.C. 102(b) as being clearly anticipated by US 6,309,300 to Glavich.

Re Claims 1, 9, 29, 36

Glavich discloses a method for playing a wagering game having a special payout, the method comprising: presenting a basic game (Abstract, a main game)

having a plurality of randomly selected outcomes being selected independently of player selection, the randomly selected outcomes including a special-payout outcome (Fig. 1 shows the main game being a 3 reel slot game and Fig. 1 **132** shows winning symbol combinations in a pay table. Spinning slot reels, initiated by the player pulling a handle (Col. 2 Lines 65-67) to obtain outcomes compared against a pay table (Col. 3 Lines 3-4), means that the player is not directly selecting the reel outcomes. Both base game slot reel combinations and bonus game picks are randomly selected by the computer, not directly by the player. Fig. 2 blocks **234-236** show that the determination of which selectable bonus game objects will cause a bonus game selection win, i.e. a special-payout outcome, is randomly selected. Col. 3 Lines 5-33 clarifies that the step of associating selectable bonus game items with prizes is performed by microprocessor **412**, not the player.); accepting a basic wager from a player for the basic game between a minimum and maximum amount (Fig. 2, a wager is received for the main game in block **212**. Col. 3 Lines 65-67 and Col. 4 Lines 1-2 disclose that optionally, the game may allow the player to make "an additional wager or side wager related to the bonusing feature".) presenting an additional, separate side-wager option for a player to place an additional side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager (Again see Col. 3 Lines 65-67 and Col. 4 Lines 1-2); in response to a player not choosing the side-wager option, providing the player with a first probability greater than zero of achieving the special-payout outcome (Columns 3 and 4 disclose that in the selection-type bonus game, the number of items associated items associated with the number of selectable

items, or in other words the number of selectable items "M" that will cause a winning bonus outcome when selected by the player, can be varied based on the same factors that "N" can be. As discussed in Col. 3 Lines 65-67, "N" can be based on the side wagers related to the bonusing feature. Hence "M" can be selected based on the side wager related to the bonusing feature as well. Specifically, Col. 3 Lines 65-67 and Col. 4 Lines 1-2 state that "in some embodiments the player may be given an option to make an additional wager or side wage related to the bonusing feature, e.g., for the purpose of increasing the value of N." Col. 5 Lines 26-42 then expounds on this concept, stating that "The M items are selected or calculated 232 in any number of fashions. In other embodiments, the M associated items may be selected using factors similar to those described above in connection with selection of the value N [...] including selecting based on the amount of wagers [...] The values of Z and N, and the items which are associated with some or all of the N selectable items, all affect the amount of bonusing prizes, averaged over a period of time.") in response to the player choosing the side-wager option, providing the player with a second probability of achieving the special-payout outcome, the second probability being greater than the first probability (see discussion above, the number of selectable items N having "associated items M", can be increased based on a side wager, for the purpose of "affecting the amount of bonusing prizes averaged over a period of time"); conducting the basic game with the first probability if the player does not choose the side-wager option (it inherent that if a side wager is not chosen, the game will be conducted according to the base wager required to play the game (212 in Fig. 2), or the second probability if the player chooses

the side-wager option (increasing the number of selectable bonus objects that will result in winning bonus picks (special-payout outcomes), based on a side wager); and in response to conducting, crediting the player the special payout when the special-payout outcome occurs in the basic game (Col. 6 Lines 37-39, if a selectable bonus item has a prize associated with it, the prize value increments on the player's machine).

Re Claims 2, 5, 7, 32, 34

The base game is shown in Fig. 1 as being a slot machine having traditional symbol-bearing reels. 132 shows a typical slot machine pay table for different base game outcomes that can occur.

Re Claims 4 and 31,

Glavich discloses that the associated items associated with some of the player-selectable items can be "additional plays of the main game". A free play of a main game constitutes a "bonus game" in the art of electronic casino gaming.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3, 12-13, 15-16, 18, 23, 25, 27-28, 30, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich.**

Re Claims 3, 23, and 30,

Glavich discloses in Col. 4 Lines 44-52 that the associated items associated with the player-selectable items of the bonus game can include monetary prizes. Glavich thus obviously encompasses providing progressive monetary prizes as associated items.

Re Claims 12, 25, and 27-28, and 37

Glavich discloses that there are various types of associated items that can be associated with the user-selectable items in a bonus round. For example see Fig. 1, in which five user-selectable items are shown. Each of these user-selectable items may, or may not, have one of various types of associated items associated with it. Glavich discloses in Col. 4 Lines 44-67 and Col. 5 Lines 1-16, what some of these types of associated items may be, such as multipliers, bonus prize values, demerits, free plays, etc. Glavich also discloses in Col. 5 Lines 28-38 that the associated items can be selected based on "factors similar to those described above in connection with selection of the value N" including "selecting based on the amount of wagers". We know from the discussion above that the "factors similar to those described above in connection with selection of the value N" also include "additional or side wagers". One of skill in the art would recognize that a system in which the types of hidden prizes associated with user-selectable items can be varied based on side wagers and additional wagers" would obviously encompass varying the types of hidden prizes when a max wager occurs, because a max wager is the highest form of an "additional wager". Because Glavich states that the items can be varied based on such factors as varying wager types or amounts, and because many different types of functions that can be associated with the

items exist in his system, such as bonus values, free plays, multipliers, etc., more than one type of award could be obtainable only when a max and/or side wager is selected, and not available when a max and/or side wager is not selected. For example, Glavich's system obviously encompasses the possibility of having a first payout of multiplier functions, and a second payout of free games, when a max wager or side wager have been utilized, but neither being available when a max wager or side wager has not been utilized.

Re Claim 13,

See the rejections of claims 3 and 4 above.

Re Claim 15,

Glavich has disclosed, as discussed above, that his system is capable of allowing the user to select side wagers, and/or wagers otherwise increased above the base level. Therefore Glavich's system must have some sort of user input devices in order for his system to be functional. These selections must be in the form of mechanical buttons, as are old and well-known in the art, or in the form of other I/O features such as icons on a touch screen, which would also meet the limitation of buttons. Glavich discloses that although a keypad can be used to enter wagers, "other components such as buttons, [or] touchscreens and the like can also be used." (Col. 2 Lines 66-67 and Col. 3 Lines 1-2.

Re Claim 16 and 18,

See the rejection of claim 2 above.

8. Claims 6, 17, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of US 6,186,894 to Mayeroff.

Re Claim 6, 17, and 33,

Glavich shows in Fig. 1 that his base game can be a slot machine having traditional symbol-bearing reels. However, Glavich is silent on the symbols on the reels being able to include symbols from a deck of playing cards.

The Mayeroff reference was discussed in the previous Office Action, the discussion of which is incorporated by reference herein. Mayeroff teaches an analogous gaming machine having a slot machine base game, in which the symbols on the reels can be any symbols representing a common theme" (See Col. 6 Lines 47-54 of Mayeroff).

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, that incorporating the well-known teaching of Mayeroff regarding what types of symbols can be used on slot reels, into Glavich's analogous slot reel base game, would yield predictable and non-inventive results.

9. Claims 8, 10-11, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of US 2004/0166918 to Walker.

Re Claims 8, 10-11, and 35,

Glavich's invention, which has the purpose of altering the probability of achieving a winning bonus pick (special-payout outcome) to a player based on changing the number of wins associated with a plurality of symbols, is applied to a selection-type bonus game in the exemplary embodiment. However, one of skill in the art would readily

be able to apply the same teaching of altering the number of winning symbols among a group of selectable game symbols, into a slot reel game, because the same result of the game controller being able to selectably alter the bonus payout to a player over a period of time, would remain the same, and also because applying Glavich's teaching to slot reels would not create any results outside of what would be expected by one of ordinary skill in the art. Walker, in fact, discloses a method an apparatus for changing the number of winning symbols on slot reels in order to modify the payout (Walker Paragraph 24, wherein the "game play parameter" includes the number of symbols on each reel, and the probability of the character appearing on a given handle pull. Paragraphs 103-104 of Walker further state that the gaming device, or the casino controlling it, can vary the game play parameters during play to control the number of bonus symbols on each reel which initiate a bonus round".) Thus it is known in the art how Glavich's invention could be readily applied to slot reels. At the time the invention was made, it would have been obvious to one having ordinary skill in the art that applying Galvich's teaching of modifying the number of symbols associated with a bonus outcome, to slot reels, as Walker discloses is known, would have predictable and non-inventive results.

10. Claims 19-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of US 2003/0064807 to Walker.

Re Claim 19,

Glavich discloses that the gaming terminal has the two options of being available for the special payout, those two options being the max wager and side wager

discussed in the rejection of claim 12 above. Glavich also discloses the gaming terminal having signage located above and coupled to the gaming terminal, the signage displaying the special payout and for receiving a signal that the gaming terminal is eligible to win a special payout (See Col. 3 Lines 5-30 of Glavich, in which he discloses that the display that is used to provide the base and bonus games of the instant invention, the bonus game including the modifiable outcomes that can be based on whether a side wager or other type of additional wager including a max wager has been selected, as discussed in the rejection of claims 1 and 12 above). Glavich states that the gaming machine used in his device may have "a communication device" for remote accounting purposes. Glavich also states that "the present invention can also be implemented in many other types of gaming devices (Col. 2 Lines 53-55". However, Glavich is silent on the gaming device being linked with other gaming devices.

Walker discloses an analogous system comprising networked casino gaming devices for playing games of chance including slot games and card games (Abstract and Paragraph 42). Walker teaches the plurality of casino gaming machines (Fig. 1A, gaming devices **104, 106, 108**) being in combination with at least one other gaming terminal (Fig. 1A, the gaming devices are networked) for conducting wagering games (Paragraph 42), the gaming terminals and the signage being a gaming system (each of the gaming devices (Fig. 1A and Paragraphs 30-32, a system for linked game play wherein players can compete as a group or against each other, and Paragraph 50, wherein each of the gaming devices has one or more video output devices).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have incorporated Walker's teaching of a single gaming machine being used in a network in order to interact with other gaming machines, into the slot machine with bonusing taught by Glavich, because networked game play is old and well-known in the art, and also because many gamblers enjoy the social interaction that linked gaming provides (Walker, Paragraph 16).

Re Claims 20-21,

Glavich's gaming devices having an output device controller for controlling their output device(s) for controlling a bonus outcome, the output device controller being controlled by a gaming terminal controller (See Glavich Fig. 4, Microprocessor **412** controls the I/O device such as the Touchscreen **416**).

Re Claim 22,

Glavich in view of Walker further teach a gaming system, wherein each of the plurality of gaming terminals are identical machines (Walker Paragraph 42, the gaming machines can be any gaming machine, including slots, poker, etc. Because each gaming machine can be any of the disclosed gaming machines, the system is inherently capable of supporting all of the machines being the same machine).

Re Claim 24,

Glavich discloses that his system can have bonus prize values associated with user-selectable items in his bonus game (Col. 6 Lines 37-40).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **STEVEN J. HYLINSKI** whose telephone number is (571)270-1995. The examiner can normally be reached on **M-Thurs. 7:00a-5:30p**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on **571-272-4437**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
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